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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,090	06/07/2001	Mark Andrew Benny	AUS920010209US1	9388

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SCHMEISER, OLSEN & WATTS
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LATHAM, NY 12110

EXAMINER

OSMAN, RAMY M

ART UNIT	PAPER NUMBER
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2457

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/876,090	Applicant(s) BENNY ET AL.	
	Examiner RAMY M. OSMAN	Art Unit 2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 24, 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/3/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is responsive to amendment filed on November 3, 2010, where Applicant submitted an IDS. Based upon the newly filed IDS, a new rejection is presented below. Claims 22,24,25 remain pending based upon the Examiners Amendment which was entered on 9/24/2010.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 22,24,25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, on line 10 of claim 22 for example, it recites “to deliver specific services to customers...”. It is unclear if this “customer” is the same as the “customer” on line 8 of the claim. Similarly on line 2,5, and 17. If these occurrences of the limitation “customer” is intended to refer to the same, then the limitations appear contradictory. If they are not the same then the limitations are unclear and are indefinite.

Secondly, the term "sufficiently" on line 11 of claim 22 for example, is a relative term which renders the claim indefinite. The term "sufficiently" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 22,24,25 rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al (International Application under PCT, WO 01/15003) in view of Mikurak (US Patent No 6671818).** (Note: Claim limitations are in italics)

Allen teaches a method for creating a technical framework for use in delivering a specific set of information technology services for a customer, comprising the steps of:

determining a solution scope for the technical framework to be created, the solution scope based on common practices for delivering certain types of information technology services (page 3 line 11 – page 4 line 20, Allen discloses a Roadmap Program (i.e. “solution scope”));

mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities (page 7 lines 25-30, Allen discloses components (i.e. “architectual building blocks”));

creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components (page 8 lines 2-6, Allen discloses streams (i.e. “*design objects*”)); and

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designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer (page 8 lines 13-20, Allen discloses dependencies (i.e. “relationships”)).

Allen fails to explicitly disclose “the solution scope guided by an information technology services contract with the customer”. However, Mikurak teaches a method of generating a contract between a software owner and a software user. This is for the purpose of creating a license agreement where it allows a vendor to maintain some control over the use of its product. (see Mikurak, at least figure 64 and column 114 lines 6-23). It would therefore be obvious to one of ordinary skill in the art to implement a service contract for the purpose of licensing.

Allen also fails to explicitly disclose “used to deliver specific services to customer”. However, the Allen reference is regarding multi-disciplined organizations (page 1 lines 2-3) within the context of business and economy (page 1). “Official Notice” is taken that is obvious to one of ordinary skill in the art the multi-disciplined organizations can be used to deliver specific services to their clients/customers. Businesses and organizations are motivated by financial reasons to provide services to clients/customers.

6. In reference to claim 24, this is a “*computer program product*” claim that correspond to the method claim of claim 22 above. Therefore, claim 24 is rejected based upon the same rationale as given for claim 22 above.

7. In reference to claim 25, this is a “*data processing system*” claim that correspond to the method claim of claim 22 above. Therefore, claim 25 is rejected based upon the same rationale as given for claim 22 above.

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Conclusion

8. The above rejections are based upon the broadest reasonable interpretation of the claims. Applicant is advised that the specified citations of the relied upon prior art, in the above rejections, are only representative of the teachings of the prior art, and that any other supportive sections within the entirety of the reference (including any figures, incorporation by references, claims and/or priority documents) is implied as being applied to teach the scope of the claims.

9. Applicant may not introduce any new matter to the claims or to the specification. For any subsequent response that contains new/amended claims, Applicant is required to cite its corresponding support in the specification. (See MPEP chapter 2163.03 section (I.) and chapter 2163.04 section (I.) and chapter 2163.06)

10. In formulating a response/amendment, Applicant is encouraged to take into consideration the prior art made of record but not relied upon, as it is considered pertinent to applicant's disclosure. See attached Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMY M. OSMAN whose telephone number is (571)272-4008.

The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ramy M Osman/
Primary Examiner, Art Unit 2457

December 16, 2010

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